

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

NAJIB et al Atty. Ref.: 3665-129; Confirmation No. 9192

Appl. No. 10/520,079 TC/A.U. 1626

Filed: April 22, 2005 Examiner: LOEWE

For: SUBSTITUTED 1,3-DIPHENYLPROP-2-EN-1-ONE DERIVATIVES,  
PREPARATION AND USES THEREOF

\* \* \* \* \*

March 18, 2009

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE**

Responsive to the Official Action dated February 18, 2009, the applicants elect, with traverse, the subject matter of the Examiner's Group I. The applicants further elect, again, as a species for initial examination, the compound 1-[4-methylthiophenyl]-3-[3,5-dimethyl-4-carboxydimethylmethyloxyphenyl]prop-2-en-1-one, which is recited in claims 96 and 97. The compound is characterized by X6 is oxygen, X2 is hydrogen and is not bound to carbon 3 of the propene chain, and the remaining substituents are as defined as follows: X1 is a G1R1 group, G1 is sulfur, R1 is methyl; X3 and X5 are R3 and R5, respectively, R3 and R5 being methyl; and X4 is a G4R4 group, G4 being oxygen and R4 being an alkyl (dimethylmethyl) containing one group consisting of COOR6 with R6 being hydrogen.

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Claims 69, 70, 74, 77, 80, 85-87, 92, 93, 96, 97, 99, 101 and 102 are believed to read of the elected species.

The further restriction requirement of the Office Action of September 22, 2008 is submitted, with due respect, to be improper and withdrawal of the restriction requirement and resumption of examination on the merits are requested.

The Examiner is requested to appreciate that the present application is a 371 U.S. National Phase of a PCT application. The principles of unity of invention therefore apply. The Examiner has not demonstrated in the Office Action of September 22, 2007 that the claims lack unity of invention. The only basis for asserting lack of unity of invention in the Office Action of September 22, 2008 is “for the reasons provided in the restriction requirement dated February 28, 2007.”

This basis for the restriction requirement of September 22, 2008 is submitted, with due respect, to be unsupportable in view of the Examiner’s opening statement in the same Office Action that “The restriction requirement dated February 28, 2007 is withdrawn in view of the new restriction requirement set forth herein.” It is unclear how the earlier restriction requirement can be withdrawn in view of the new restriction requirement which is asserted for the same reasons as the now-withdrawn earlier restriction requirement. Moreover, if the earlier restriction requirement is withdrawn it would appear reasonable that the applicants should receive an examination on the previously-claimed subject matter which was withdrawn from consideration by the previous Examiner as a result of the now-withdrawn restriction requirement.

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The subject matter of the Examiner's Groups of allegedly separately patentable inventions in the Office Action of September 22, 2008 define products (Group I), a method of making the products (Group II) and methods of using the product (Group III). The Office Action of February 28, 2007 confirmed that the PCT Rules and Administrative Instructions permit inclusion of claims to a product, claims to a process of making the product and claims to methods of using the product in a single application. See page 2 of the Office Action dated February 28, 2007 and the reproduction of Annex B, Part 1(e) of the Administrative Instructions Under the PCT contained therein. The further restriction requirement of the Office Action dated September 22, 2008 is therefore submitted to be contrary to the PCT Rules and Administrative Instructions. Withdrawal of the restriction requirement and resumption on examination on the merits is requested.

The applicants have received two (2) examination reports (i.e., Office Actions) on the merits and the claims have been revised over the past year-and-a-half of prosecution to define patentable subject matter.

In the event the restriction requirement of September 22, 2008 is maintained, the Examiner is requested to withdraw the provisional obviousness-type double patenting rejection of the claims defining the subject matter of the Examiner's Group III in the Office Action of September 22, 2008 over claims defining compounds in at least application no. 10/520,078.

Additional art which is of record in application no. 10/520,078, has been recently filed for the Examiner's consideration. The copending application has been the basis of

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an obviousness-type double patenting rejection. Return of an initialed copy of previously filed PTO-1449 pursuant to MPEP § 609 is requested.

An early and favorable Action on the merits of all of the claimed subject matter is requested.

Respectfully submitted,

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